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10/505,356	08/19/2004	Gerald J Julien	Ice US1	5987
J. Michael Neary 53939 Pine Grove Road LaPine, OR 97739				
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EXAMINER				
WALTERS, JOHN DANIEL				
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/505,356
Filing Date: August 19, 2004
Appellant(s): JULIEN, GERALD J

J. Michael Neary
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6 July 2009 appealing from the Office action mailed 6 February 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,318,738 B1	Abkowitz, et al.	11-2001
WO 97/29892	Julien	8-1997

Appellant's admitted prior art, US Application 10/505,356 (21 FEB 2002), specification page 5 and figure 1.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 4 and 13 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appellant's disclosure in view of Abkowitz et al. (6,318,738) and Julien (WO9729892). Appellant's disclosure states that the following physical structures are "...conventional and are well known to those skilled in the art":

- a blade body having an ice contacting bottom edge (Fig. 1, item 30);
- said blade body having a structure for engaging a blade holder (Fig. 2, item 34);
- said bottom edge having opposed corners that are sharpened (Fig. 3);
- said blade holder being connected to a boot (Fig. 1).

Abkowitz discloses titanium composite skate blades comprising:

- a titanium material blade, defined as any of the following: pure titanium, titanium alloys, or titanium matrix composites (column 2, lines 41 – 44).

It would have been obvious to one of ordinary skill in the art at the time of Appellant's invention to combine the old and well known blade structure with the titanium material of Abkowitz in order to provide improved strength, corrosion resistance, wear resistance and reduced weight (column 1, lines 59 – 62).

Abkowitz does not specifically disclose the use of Type 60 Nitinol, however, Julien discloses a blade comprising:

- an inter-metallic compound of about 60% nickel and about 40% titanium by weight (abstract).

Appellant lists many standard physical properties for "Type 60 Nitinol" within claims 1 – 4 and 13 – 20. Any material selected for manufacturing would provide a set of differing properties, as these properties are dependent upon the physical and chemical structure of each individual material. The choice of "Type 60 Nitinol" would, therefore, require that the material properties be in line with those that are seen in the material.

It would have been obvious to one of ordinary skill in the art at the time the instant invention was manufactured to construct the skate blade, as taught by Appellant's admitted prior art in view of Abkowitz, with the material of Julien, in order to provide corrosion resistance, hardness, toughness and flexibility, (Julien page 17, lines 6 - 13).

(10) Response to Argument

Appellant states, "Abkowitz specifies skate blade materials made of a titanium alloy 'which is reinforced by a hard constituent' (col 2, lines 5-6)...Abkowitz does not disclose or suggest the use of 60 Nitinol as a skate blade material, even though it was known long prior to the time of his invention."

While Appellant is correct in stating that Abkowitz specifies a very specific type of titanium composite, Abkowitz states, "As used herein, 'titanium material' refers to any titanium based material such as commercially pure titanium, titanium alloys and titanium matrix composites." It is clear that Abkowitz teaches that the inclusion of titanium within materials chosen for skate blades would be useful. One of ordinary skill in the art would be well within their skill and knowledge, in light of this teaching, to potentially manufacture a skate blade with any titanium containing material.

Appellant also states, "WO97/29,892...This reference makes a very good case for 60 Nitinol as a cutting instrument, but there is noting in the disclosure or in the

properties of 60 Nitinol as disclosed in this publication that would lead a person of ordinary skill in the art to make skate blades of 60 Nitinol."

This reference is not included to provide a teaching linking Type 60 Nitinol to the manufacture of skate blades. Abkowitz provides the teaching regarding the use of titanium containing materials in the manufacture of skate blades. The Julian reference is provided as a showing that Type 60 Nitinol was known prior to the filing of the instant application. Appellant appears to be arguing the individual references of the combination rejection separately.

Appellant provides a long discussion on the Rule 132 Declaration provided by Susan Buchanan, President of Triumph Sport, Inc., licensee of the instant application. Abkowitz specifically and directly states that titanium alloys are appropriate materials for use in skate blades. This direct statement of applicability would lead one of ordinary skill in the art to consider and potentially pursue the use of a titanium alloy, such as one of the various formulations of Nitinol, in the construction of a skate blade. One cannot disregard the direct suggestion by Abkowitz to investigate the use of titanium and titanium alloys in the manufacture of skate blades.

The Rule 132 Declaration contains no data, only the opinion of an interested party. While Appellant provided a report commissioned by Triumph Sport, Inc., the report was neither published and introduced via an IDS nor submitted as a Rule 132 Declaration and thus has not been officially considered.

Regardless of its current status, the data contained within the report makes a comparison between a standard skate blade and the instant invention. For such data to be applicable it would need to be a direct comparison of the claimed invention with the closest prior art (i.e. Abkowitz) which is commensurate in scope with the claims, the results must be due to the claimed features not to unclaimed features and the burden would be on the Appellant to establish that the results are in fact unexpected, unobvious and of statistical and practical significance. Were the report to be properly submitted, it still would fail to be a comparison with the closest prior art.

In Appellant's discussion of dependent claims 2, 3 and 14 - 20, no mention is made to the grounds of rejection listed above and in the prior rejection. Appellant repeatedly makes statements regarding what the Abkowitz and Julien references may or may not teach, but these references are not relied upon for the rejection of these claims. As stated above, Abkowitz is provide for the teaching of the use of a titanium containing material in skate blades and Julian is provided to show the existence of Type 60 Nitinol before the instant invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/John D. Walters/

Examiner, Art Unit 3618

/Paul N. Dickson/

Supervisory Patent Examiner, Art Unit 3616

Conferees:

Paul N. Dickson /pnd/

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